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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,743	04/18/2000	Roger P. Jackson	99.198	2761

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/552,743	Roger Jackson
	Examiner Brian E Pellegrino	Art Unit 3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 December 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 31-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 31-41 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____

DETAILED ACTION

Continued Prosecution Application

The request filed on 12/23/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/552743 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 31,37 are rejected under 35 U.S.C. 102(b) as being anticipated by Pisharodi (5693100). Figs. 5 and 6 show a spinal implant having upper and lower walls (34, 36 respectively). It can also be seen in said Figures a post 42 is mounted in a posterior wall and extends to near the anterior end. Claims in a pending application should be given their broadest reasonable interpretation. In re Hyatt, 211 F.3d 54 USPQ2d 1664 (Fed. Cir. 2000). In this instance, the examiner is interpreting the posterior wall having a cylinder attached thereto to receive the post to be an expansion member since it engages and forces the upper and lower walls to expand as it pulls the other end towards it and results in the upper and lower walls to be displaced into a predetermined non parallel angle relative to one another. Additionally, since each of the upper and lower portions of the implant consists of two subunits, it can be construed that the subunits in the anterior area are expanded. A fastener 40 secures a cover 33 (having upper and lower support surfaces) to the post. Regarding claim 37, it can be construed

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that Pisharodi discloses a cylindrical implant in Figs. 7,8. At an anterior end is an end cover 33 with upper and lower surfaces that provide support to the anterior end.

Claims 33,35-37,39 are rejected under 35 U.S.C. 102(e) as being anticipated by Nolan (6117174). Nolan discloses an implant (Fig. 6a) for implanting between a adjacent vertebrae and is adapted to promote bone growth, col. 4, lines 40-46. Claims in a pending application should be given their broadest reasonable interpretation. In re Hyatt, 211 F.3d 54 USPQ2d 1664 (Fed. Cir. 2000). In this instance, the examiner is interpreting the threaded portion of implant end cover 82 to be an "expansion cap" since it has threads which can be construed to couple it to the implant. Additionally, it can be seen in said Figure that the cover has upper and lower support surfaces sized and shaped to engage and operably support an anterior region of the vertebrae. It can also be seen in said Figure that the implant includes an interior chamber 52 for receiving bone fragments and radially positioned apertures 42. Regarding claim 37, Fig. 16, shows the implant is cylindrical, and Fig. 17 shows an implant end cover 14' operably located at an anterior end and the upper and lower surfaces are sized, shaped to provide additional anterior support to the vertebrae.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pisharodi '100 in view of Lahille et al. (5554191). Pisharodi is explained supra. It can also be seen in Figs. 6 and 8 that the implant includes an interior chamber for bone fragments. However, Pisharodi does not disclose the implant as having apertures for permitting bone ingrowth. Lahille et al. teach (Fig. 6) an opening **35** that is placed in the implant's upper and lower branches for bone ingrowth, col. 2, lines 51-54. It would have been obvious to one of ordinary skill in the art to use openings in the sides as taught by Lahille with the implant of Pisharodi in order to enhance the fusion of adjacent vertebrae.

Claims 34,40,41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolan '174 in view of Lahille et al. '191. Nolan (Fig. 17) shows an implant **10** having upper and lower walls joined by a posterior wall **82**. It can also be seen in said Figure that there is an anterior expansion member **14'** that is sized and shaped to remain in contact with upper and lower walls to provide support for the anterior end. However, Nolan fails to disclose using a post in the posterior wall that is coupled to the anterior expansion member. Lahille teaches (Fig. 6) to use a post **36** mounted in the posterior wall of a vertebral implant to pull an expansion member posteriorly inwards. Fig. 15 shows a fastener **363** to secure expansion member to post. Regarding claim 34, it would have been obvious to one of ordinary skill in the art to include a recess in the threaded portion for receiving a fastener as taught by Lahille with the implant of Nolan in order to prevent the end cover from being displaced. With respect to claim 40, it would have been obvious to one of ordinary skill in the art to use a post as taught by Lahille et

al. to pull the expansion member of Nolan posteriorly along the post such that the expansion member cannot be displaced from the anterior end and collapse.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nolan '174 in view of Pisharodi (5658336). Nolan is explained supra. However, Nolan does not disclose the surfaces of the cover extend from side to side along more of the vertebrae than the implant. Pisharodi teaches (Fig. 2) an end cover **24** that is placed beyond the implant's sides to stabilize the implant between vertebrae, col. 4, lines 1-3. It would have been obvious to one of ordinary skill in the art to use a more supportive end cover as taught by Pisharodi with the implant of Nolan in order to better stabilize the adjacent vertebrae.

Response to Arguments

Applicant's arguments filed 12/23/02 have been fully considered but they are not persuasive. In response to applicant's argument that the Nolan reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., flat surfaces is not recited in claim 37) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's arguments with respect to claims 31,33,38,40 etc. have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 9am to 6:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino
TC 3700, AU 3738
March 8, 2003



Bruce Snow
Primary Examiner

